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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL R. NOWAK, LOUANN S. MUELLER, and
WILLIAM R. ARNDT

Appeal 2009-009885
Application 10/094,060
Technology Center 1700

Decided: August 18, 2009

Before CATHERINE Q. TIMM, ROMULO H. DELMENDO, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

DELMENDO, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 19, 20, 22-29, and 31-36 (Amended Appeal Brief filed September 12, 2008, hereinafter “App. Br.” at 1; Final Office Action mailed November 15, 2007). We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

STATEMENT OF THE CASE

Appellants' claimed invention relates to a wrapped ream of paper comprising a particular composite wrap material (claim 19; Specification, hereinafter "Spec.," 4, ll. 14-21). According to Appellants, the composite wrap material provides: (i) a wrapped package having high burst strength; (ii) a barrier against moisture absorption by the wrapped contents; (iii) fold characteristics of paper; and (iv) a high gloss print surface or standard paper print surface (Spec. 3, ll. 18-20 and 28-29; 4, ll. 3-4 and 7-8).

Claim 19 is representative and reads as follows:

19. A wrapped ream of paper, comprising: a laminated composite wrap material including a first layer of paper having an inner surface and an outer surface, said first layer of paper comprising tissue, air laid fabric, wet laid fabric or creped tissue; a second layer of polymer film material having an outer surface and an inner surface; and an adhesive layer between the inner surfaces of said first and second layers; wherein said laminated composite wrap material wraps said ream of paper, the outer surface of said first layer of paper is coated by a polyethylene layer, and the inner surface of said second layer of polymer film material is printed before lamination.

(App. Br. 7; Claims App'x.)

The Examiner relied upon the following as evidence of unpatentability (Examiner's Answer mailed December 5, 2008, hereinafter "Ans.," 3):

Gatewood US 2002/0050119A1 May 2, 2002¹

The Examiner rejected claims 19, 20, 22-29, and 31-36 under 35 U.S.C. § 103(a) as unpatentable over Gatewood.

¹ Gatewood has a filing date of September 28, 2001 and claims priority to Provisional Application 60/236,988 filed on September 29, 2000.

ISSUES

Based on specific findings of fact and reasoning, the Examiner concluded that the subject matter recited in the appealed claims would have been obvious to one of ordinary skill in the art in view of Gatewood's teachings (Ans. 3-4). According to the Examiner, Gatewood is available as prior art because the current application is not entitled to benefit of an earlier effective filing date based on parent Application 09/178,329 ('329 Application) filed on October 23, 1998 (Ans. 4-6).² Specifically, the Examiner found that the '329 Application does not provide written description "support for the claimed wrapped ream of paper wherein the wrap has either of the following structures: *printed polymer film/adhesive/paper/coating layer of polyethylene* as in instant Claim 19 or *polymer film/adhesive/printed paper/coating layer of polyethylene* as in instant Claim 28; more specifically, the coating layer of polyethylene . . ." (*id.* at 5; underscoring added).

Appellants do not dispute the Examiner's obviousness conclusion based on Gatewood's teachings (App. Br. 4-6). Rather Appellants argue that Gatewood is not available as prior art under any subsection of 35 U.S.C. § 102 because the current application is entitled to the benefit of the earlier filing date of the '329 Application (*id.*). Appellants assert that support for the subject matter of the appealed claims is found in paragraphs [0023] and [0003] of the '329 Application (*id.* at 4-5).

² When referring to the '329 Application, we cite to the published application (US 2003/0129431 published on July 10, 2003).

Thus, the dispositive issue arising from the contentions of the Examiner and Appellants is:

Have Appellants shown reversible error in the Examiner's factual finding that paragraphs [0023] and [0003] of the '329 Application do not provide written description support for the subject matter of the appealed claims including the limitation "the outer surface of said first layer of paper is coated by a polyethylene layer" as recited in claims 19 and 28, the sole independent claims on appeal?

FINDINGS OF FACT ("FF")

1. Paragraph [0003] of the published '329 Application states:

Conventional commercial wrappers include paper/polyethylene/paper laminates, paper/wax/paper laminates, *polyethylene-coated papers*, wax-coated papers, and transparent polymer films. A drawback of paper based wrap materials is their low burst strength. Oftentimes, such packages tend to break open before reaching the consumer because the wrapper is not strong enough to hold the paper upon repeated handling and stacking on store shelves. This not only ruins the product by causing an unsightly appearance on a store shelf, but can damage the paper which can cause copiers and printers to become jammed.

(Emphasis added.)

2. Paragraph [0023] of the published '329 Application further discloses:

In use, one side of the wrap material is placed next to the paper or other material being wrapped. The other side of the wrap material may be printed upon using known printing techniques, or the paper layer 15 or film layer 20 can be printed before lamination, and then laminated so the print shows through the film layer.

3. The current application was filed on March 8, 2002.

PRINCIPLES OF LAW

“Claims found in a later-filed application are entitled to the filing date of an earlier application if, *inter alia*, the disclosure in the earlier application provides an adequate written description of the later-filed claims under 35 U.S.C. § 112, ¶ 1.” *In re Curtis*, 354 F.3d 1347, 1351 (Fed. Cir. 2004).

“A disclosure in a parent application that merely renders the later claimed invention obvious is not sufficient to meet the written description requirement; the disclosure must describe the claimed invention with all its limitations.” *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1158 (Fed. Cir. 1998).

ANALYSIS

Appellants argue the appealed claims together, relying solely on the contention that Gatewood is not prior art. *See* 37 C.F.R. § 41.37(c)(1)(vii).

We are in complete agreement with the Examiner that the relied upon disclosures in the ‘329 Application do not provide adequate written description for the subject matter recited in claim 19 or claim 28, including the limitation “outer surface of said first layer of paper is coated by a polyethylene layer.” The only reference to polyethylene in the relied upon portions of the ‘329 Application is in a discussion of conventional or commercially available “polyethylene-coated papers” *per se*, which is said to have the “drawback of . . . low burst strength” (FF 1). In this context, Appellants distinguish the claimed invention over the prior art polyethylene-coated papers disclosed in the ‘329 Application. Thus, the relied upon disclosure would not have reasonably conveyed to one skilled in the relevant

art that Appellants possessed the now-claimed subject matter as their invention at the time the '329 Application was filed. *See Tronzo*, 156 F.3d at 1159 (“[T]he only reference in the ‘589 patent’s specification to different shapes [for a cup in a prosthesis] is a recitation of the prior art Instead of suggesting that the ‘589 patent encompasses additional shapes, the specification specifically distinguishes the prior art as inferior and touts the advantages of the conical shape of the ‘589 cup.”) (Internal citation omitted.)

Paragraph [0023] of the '329 Application does not cure the deficiency of paragraph [0003] (FF 2). Accordingly, paragraph [0023] also fails to reasonably convey to one skilled in the relevant art that Appellants possessed the now-claimed subject matter as their invention at the time the '329 Application was filed.

Since Appellants did not demonstrate that the appealed claims are entitled to the benefit of an earlier filing date of the '329 Application, Gatewood is available as prior art under 35 U.S.C. § 102 (FF 3).

CONCLUSION

Appellants have not shown reversible error in the Examiner’s factual finding that paragraphs [0023] and [0003] of the '329 Application fail to provide written description support for the subject matter of the appealed claims including the limitation “the outer surface of said first layer of paper is coated by a polyethylene layer” as recited in claims 19 and 28.

DECISION

The Examiner’s decision to reject appealed claims 19, 20, 22-29, and 31-36 under 35 U.S.C. § 103(a) as unpatentable over Gatewood is affirmed.

Appeal 2009-009885
Application 10/094,060

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(v).

AFFIRMED

MAT

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